

Remarks

Reconsideration of this Application respectfully is requested.

Status of the Application and Claims

Claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 are pending in the application, with claims 3, 4, 15, 16, 23, 26, 27, and 42 being the independent claims. Claims 3, 4, 6, 9, 10, 16, 23, 26-29, 32, 33, 35-37, and 42-46 are amended herein. No new matter has been added.

Substance of the Decision on Appeal

In a Decision on Appeal dated December 22, 2010 (“the Decision on Appeal”), the Board of Patent Appeals and Interferences (“the Board”) reversed the Examiner’s final rejection of Claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 over U.S. Patent Application Publication 2003/0229638 (“the Carpenter publication”), and affirmed the Examiner’s rejection of claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101, based on a new ground of rejection first raised by the Board. Specifically, at page 10 of the Decision on Appeal, the Board stated the following Conclusions of Law:

(1) Appellants have not shown that the Examiner erred in concluding that claims 3-6, 9, 10, and 34-37 are directed to an abstract idea.

(2) Appellants have shown that the Examiner erred in finding that Carpenter describes “calculating a ratio of resumes associated with the matched category to job listing associated with the matched employment category” as recited in claim 3.

(3) Appellants have shown that the Examiner erred in finding that Carpenter describes “incrementing a first counter associated with the matched employment category when the employment resource is a resume; and incrementing a second counter associated with the matched employment category when the employment resource is a job listing” as recited in claim 4.

As further discussed below, the Board’s Conclusion of Law #(1) is a new ground of rejection, because the Examiner did *not* conclude that “claims 3-6, 9, 10, and 34-37 are

directed to an abstract idea,” and this new ground of rejection was not presented in the Examiner’s Answer. Accordingly, Appellants respectfully request that prosecution be reopened under 37 C.F.R § 41.50(b)(1), as discussed herein.

Allowable Subject Matter

Initially, Appellants gratefully acknowledge the Board’s Decision on Appeal reversing the Examiner’s final rejection of claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 over the Carpenter publication, as stated in the Board’s Conclusions of Law (*supra*).

There being no outstanding rejection of claims 15-18, 21-23, 26-29, 32, 33, and 38-42 upon the Board’s Decision on Appeal, Appellants submit that these claims are in condition for allowance. *See*, 37 C.F.R § 41.54 and MPEP §§ 1214.01, 1214.04, 1214.06.

Request to Reopen Prosecution Under 37 C.F.R § 41.50(b)(1)

Appellants respectfully request that prosecution of the application be reopened under 37 C.F.R § 41.50(b)(1). This rule provides that Appellants may reopen prosecution of an application after receiving a decision on appeal that presents a new ground of rejection. Specifically, 37 C.F.R § 41.50(b)(1) provides:

§ 41.50 Decisions and other actions by the Board

...

(b) Should the Board have knowledge of any grounds not involved in the appeal for rejecting any claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the

examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subparagraph.

New Ground of Rejection

Appellants respectfully submit that the Decision on Appeal dated December 22, 2010 presents a new ground of rejection under 35 U.S.C. § 101.

In the Final Office Action mailed January 4, 2008, claims 3-6, 9, 10, 15-18, 21-23, 26-29, and 32-46 were rejected under 35 U.S.C. § 102, as allegedly anticipated by U.S. Patent Application Publication No. 2003/0229636 to Carpenter.

Appellants filed an Appeal of the Examiner's final rejection under 35 U.S.C. § 102, and filed a Brief on Appeal on July 24, 2008.

In the Examiner's Answer, filed November 13, 2008, the Examiner presented a new ground of rejection. The Examiner newly rejected claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101, as allegedly being ineligible for patenting. Specifically, the Examiner asserted the claims failed to satisfy the "machine or transformation test." In particular, at pages 3-4 of the Examiner's Answer, the Examiner stated:

NEW GROUND(S) OF REJECTION

Claim Rejections -35 U.S.C. § 101 (new)

...

Claims 3-6, 9, 10, and 34-37 are rejected under 35 U.S.C. § 101 based on Supreme Court precedent, and recent Federal Court decisions. For a process to be patentable subject matter under § 101 the process must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform subject matter to a different state or thing. See Diamond v. Diehr, 450 US 175, 184 (1981); Parker v Flook, 437 US 584, 588 n9 (1978); Gottschalk v. Benson, 408 U.S. 63, 70 (1972); Cochrane v. Deener,

94 US 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process. To qualify under § 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the present case, none of method (process) claims 3-6, 9, 10, and 34-37 transforms subject matter to a different state or thing or recite a particular apparatus for performing the steps of the method. Rather, all of the steps may be performed by human, by hand, or by mental steps. As such the invention as claimed is ineligible for patenting under 35 U.S.C. § 101.

In a Reply Brief filed December 22, 2008, Appellants submitted arguments opposing the Examiner's new ground of rejection under 35 U.S.C. § 101 with respect to each of claims 3-6, 9, 10, and 34-37. In particular, Appellants argued that these claims satisfy the "machine-or-transformation" test in view of the Federal Circuits decision in *In re Comiskey*, No. 2006-1286, slip op. at 23-24 (Fed. Cir. Sep. 20, 2007). (Reply Brief at 16).

In the Decision on Appeal dated December 22, 2010, the Board affirmed the Examiner's rejection of claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101, but on further new grounds. Specifically, the Board states:

ANALYSIS

Section 101 rejection of claims 3-6, 9, 10, and 34-37

The Examiner finds that claim 3 neither recites a particular machine nor transforms subject matter to a different state or thing. Ans. 3

Appellants contend that claim 3 clearly recites patent-eligible subject matter for a method, including accessing an employment resource via the network. Reply Br. 15-16.

...

Thus, we find that claim 3 fails to satisfy either inquiry of the "machine-or-transformation" test.

...

However, our guidance from the Supreme Court in Bilski indicates that the “machine-or-transformation” test is not the final inquiry under 35 U.S.C. § 101. We must further analyze claim 3 under the Supreme Court’s precedents on the unpatentability of abstract ideas.

(Decision on Appeal at page 5, emphasis added).

For at least the above reasons, Appellants submit that the Board's statement in the Decision on Appeal presents a new ground of rejection of claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101.¹

Board's New Grounds of Rejection Under 35 U.S.C. § 101 Traversed

Appellants respectfully request further prosecution of the application before the Examiner under 37 C.F.R. § 41.50(b)(1) with regard to the Board's affirmance of the Examiner's rejection of claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101, based on new ground of rejection of the Board (further, new analysis under the “abstract idea” test).

Appellants submit that the Board's analysis and conclusions under the new ground of rejection (further, new analysis under “abstract idea” test) are inconsistent with current Supreme Court and Federal Circuit case law. *See, Bilski v. Kappos*, 130 S.Ct. 3218 (2010) and *Research Corporation Technologies, Inc., v. Microsoft Corporation*, No. 2010-1037, slip op. (Fed. Cir. Dec. 8, 2010).

In *RCT v. Microsoft*, the Federal Circuit reversed a lower court's finding of ineligible subject matter under 35 U.S.C. § 101 with regard to a method for the halftoning of gray scale images. In its decision, the Federal Circuit noted the Supreme Court's recent decision in *Bilski v. Kappos*, and its admonition that “Congress plainly contemplated that the patent laws

¹ Although the cited statement of the Board refers only to independent claim 3, the Board applied the same analysis to all claims 3-6, 9, 10, and 34-37. (See Decision on Appeal at page 7).

would be given wide scope.” *RTC v. Microsoft*, slip op. at 13. Regarding “abstractness,” the Federal Circuit referred to the Supreme Court’s guidance in *Bilskey*, stating:

With that guidance , this court also will not presume to define “abstract” beyond the recognition that this disqualifying characteristic should exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention to the patentability criteria of the rest of the Patent Act. In that context, this court perceives nothing abstract in the subject matter of the processes claimed in the '310 and '228 patents. The '310 and '228 patents claim methods (statutory “processes”) for rendering a halftone image of a digital image by comparing, pixel by pixel, the digital image against a blue noise mask.

The invention presents functional and palpable applications in the field of computer technology. These inventions address “a need in the art for a method of and apparatus for the halftone rendering of gray scale images in which a digital data processor is utilized in a simple and precise manner to accomplish the halftone rendering.” [patent cite omitted] The fact that some claims in the '310 and '228 patents require a “high contrast film,” “a film printer,” “a memory,” and “printer and display devices” also confirm this court’s holding that the invention is not abstract. Indeed, this court notes that inventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act.

This court also observes that the claimed methods incorporate algorithms and formulas that control the masks and halftoning. These algorithms and formulas, even though admittedly a significant part of the claimed combination, do not bring the invention even close to abstractness that would override the statutory categories and context. The Supreme Court has already made abundantly clear that inventions incorporating and relying upon even “a well known mathematical equation” do not lose eligibility because “several steps of the process [use that] mathematical equation.” *Diehr*, 450 U.S. at 185. Indeed, the Supreme Court counseled:

“In determining the eligibility of respondents’ claimed process for patent protection under section 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.”

Id. at 188. Borrowing from the reasoning of the Supreme Court in *Diehr*, this court observes that the patentees here “do not seek to patent a mathematical formula. Instead, they seek patent protection for a process of” halftoning in computer applications. *Id.* at 187. Moreover, because the inventions claimed in the '310 and '228 patents are directed to patent-eligible subject matter, the process claims at issue, which claim aspects and applications of the same subject matter, are also patent-eligible.

(*RTC v. Microsoft*, slip op at 14-16).

Appellants submit claims 3-6, 9, 10, and 34-37 satisfy the “abstract idea” test of 35 U.S.C. § 101 for at least the same reasons set forth by the Federal Circuit in *RCT v. Microsoft*. The subject application claims methods (statutory “processes”) for generating employment market statistics from a network. The invention presents functional and palpable applications in the field of computer technology, including spider engine and network (e.g., the Internet) technology. Some of the claims are directed to specific apparatus, e.g., “means for plotting.” As stated by the Federal Circuit, “inventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act.” *See RCT Supra*. Although the rejected claims implement a mathematical algorithm, Appellants submit the claimed method does not pre-empt all use of the mathematical algorithm, and “does not bring the invention even close to abstractness that would override the statutory categories and context.” *See RCT Supra*. Appellants submit the Board’s 35 U.S.C. § 101 analysis at page 7 *et seq.* improperly analyzes the claims with respect to method elements individually, rather than analyzing the claims as a whole. *See RCT Supra*. Finally, Appellants submit that since claims in the application are patent eligible (claims 15-18, 21-23, 26-29, 32, 33, and 38-42 were deemed patent-eligible), “the process claims at issue, which claim aspects and applications of the same subject matter, are also patent-eligible.” *See RCT supra*.

For at least the above reasons, Appellants submit the Board’s affirmance of the rejection of claims 3-6, 9, 10, and 34-37 under 35 U.S.C. § 101, on the Board’s new ground of failing the “abstract idea” test, is in error.

Reconsideration and withdrawal of the Board’s rejection respectfully is requested.

Statement of Substance of Examiner Interview

Appellants' attorney gratefully acknowledges the courtesies extended to him by Supervisory Examiner Boswell in Telephone Interviews on February 16 and 17, 2011 ("Interviews"). In the Interviews, Appellants' attorney reviewed the status of the application and Appeal, and discussed various options for taking further action in view of the Decision on Appeal. In particular, Appellants' attorney discussed possible amendments to independent claims 3 and 4 to obviate the rejection under 35 U.S.C. § 101, including Board's the new grounds for rejection. Examiner Boswell tentatively agreed that proposed amendments tying the method(s) to particular apparatus (e.g., "a data processing device") appeared to overcome the rejection under 35 U.S.C. § 101. Appellants' attorney also proposed amendments to pending claims not rejected in the Decision on Appeal, as to form, consistent with preferred practice and changes to United States Patent and Trademark Office examination guidelines during pendency of the Appeal. The Examiner tentatively agreed the proposed amendments would meet the current examination guidelines.

The substance of the interview is incorporated in the present amendments and reply.

Amendments to the Claims

Without conceding the propriety of the rejection under 35 U.S.C. § 101 (including the Board's new ground of rejection under the "abstract idea" test), independent claims 3 and 4 are amended herein more clearly to recite various features of the claims, with particular attention to the Board's comments and the Examiner's comments in the Interviews. In particular, each of independent claims 3 and 4 has been amended herein to recite particular apparatus ("a data processing device"), wherein the method(s) recited in independent claims

3 and 4, and their respective dependent claims 5, 6, 9, 10, and 34-37, is data processing device centric, and expressly tied to particular apparatus.

Claims 16, 23, 26-29, 32, 33, and 42-46 also have been amended herein as to form, with particular attention to Examiner Boswell's comments in the Interviews.

Support for the amendments may be found throughout the original application, including the original claims and FIGs. 1-7 and 8A-8C. See also, e.g., paragraph nos. [0028] and [0074]-[0075]. No new matter has been added.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 (including the Board's new ground of rejection under the "abstract idea" test), respectfully are requested in view of the above amendments and remarks.

Conclusion

Appellants believe the present Amendment and Reply is fully responsive to each of the points raised by the Board in the Decision on Appeal dated December 22, 2010, and the Examiner's comments in the telephone interview, and submit that the application is in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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